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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

DATE MAILED: 01/21/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/987,196

Applicant(s)

ERDMAN, CAROL L.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 10/21/03 have been fully considered but they are not persuasive. Regarding claim 52, applicant argues the use of the trademarks in the specification and claims is permissible according to M.P.E.P. 608.01(v) if the meaning of the trademark is well known and satisfactorily defined in the literature. The examiner has considered M.P.E.P. 608.01(v) and notes that the relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language. *Ex Parte Kattwinkle*, 12 USPQ 11 (Bd. App. 1931). The examiner contends that since the trademark constitutes a claim limitation, the characteristics of the product known at the time the application was filed should be disclosed to properly determine the metes and bounds of the claim.

2. Regarding the rejection of claims 1-120, 14-17, 19-22, 24-27, 29-44, 46-49, and 51 as being anticipated by Roe USPN 5998695, applicant's arguments are not persuasive. Applicant argues Roe does not disclose a topsheet that has a hydrophilic

treatment on only a portion of a surface of the topsheet. It is noted that the features upon which applicant relies (i.e., only a portion of a surface of the topsheet) are not recited in the rejected claim(s). Amended independent claim 1 recites "corresponds to a portion of a surface". This does not confine the hydrophilic zone to *only a portion*.

Given the broadest reasonable interpretation, any part of the hydrophilic treated topsheet can constitute a portion of the surface of the topsheet, and can be construed as a hydrophilic zone. Furthermore, because the claim states "at least one treated hydrophilic zone", this allows for various portions of the topsheet to be construed as hydrophilic zones. Applicant additionally argues the hydrophilic zone does not correspond to just any portion of a surface of the topsheet that is treated to be hydrophilic and the inventor has measured and disclosed the precise size and location of insult points for both male and female babies. However the size and location parameters have not been used to define a predetermined insult point in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. Applicant argues Roe does not disclose a topsheet that has at least one treated hydrophilic zone that comprises a skin-wellness substance as the hydrophobic lotion composition is an alternative the hydrophilic treatment. The examiner interprets Roe to disclose at col. 6, lines 1-51 a topsheet that may be made of hydrophobic materials, and if made of hydrophobic materials, at least the upper surface is treated to be hydrophilic

to allow liquids to transfer through the topsheet more rapidly. The omission of the hydrophilic treatment is applicable to an apertured topsheet, which has apertures large enough to allow the penetration of aqueous fluids like urine without significant resistance. In the absence of an apertured topsheet, a hydrophilic treatment is desired for the reasons stated above. Otherwise, a hydrophobic non-apertured topsheet may impede the flow of fluids through the topsheet. Roe discloses the lotion composition as appropriate for being used alone or with a hydrophobizing treatment. In the event that the lotion composition is used alone, one would still have a topsheet with a hydrophilic treatment and a lotion composition. The fact that the lotion composition is hydrophobic further validates the use of a hydrophilic treatment, particularly on a non-apertured topsheet.

4. Regarding the rejection of claims 51-52 as being anticipated by Paul et al. USPN 6217890, applicant's arguments are not persuasive. Applicant argues that Paul discloses a lotion formulation that is consistent with a hydrophobic and not a hydrophilic composition. The examiner points out on page 4 of the office action mailed 5/22/03 that Paul discloses an amount of surfactant sufficient for rendering substantially hydrophilic an inherently hydrophobic material comprising nonwoven fibers or films (col. 13, lines 22-54 of Paul). The lotion composition of Paul is not intended to block the penetration of fluids through the topsheet, therefore, even though the lotion composition may be itself hydrophobic, the combination of the lotion composition and the surfactant still presents a hydrophilic surface for the penetration of fluids.

5. Applicant argues Paul does not disclose a method whereby the composition is aerosolized. Applicant has not claimed the composition is aerosolized, but that the composition is aerosolizable, which constitutes an intended use of the composition. A, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

6. Applicant's arguments with respect to claims 13, 18, 23, 45, and 50 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 52 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the trademarks TRITON GR-5M, TRITON X-200, TRITON X-100, AND SILASTOL PST has been noted in claim 52. The use of a

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trademark or trade name to identify or describe a particular material or product does not comply with the requirements of the 35 U.S.C. 112, second paragraph. *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. MPEP 2173.05(u).

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-12, 14-17, 19-22, 24-27, 29-44, 46-49, and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Roe USPN 5998695.

As to claims 1-3, 9-12, 14-17, 19, 21, 22, 24-27, 29, 31-35, 41-44, 46-49, Roe discloses an absorbent article comprising **20**: a front and rear waist portion cooperating to form a waist opening (Figure 2); a crotch region formed between the front waist and rear waist portions (Figure 2); a selectively-permeable topsheet **24**. The topsheet is selectively permeable as Roe discloses the topsheet may comprise hydrophobic fibers

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(col. 6, lines 1-14) and treated to be hydrophilic on an upper (outer) surface. Therefore, the lower (inner surface) is hydrophobic (col. 6, lines 1-14). The article further includes a substantially impermeable backsheet **26**, and an absorbent core **28** disposed between the selectively-permeable topsheet and substantially impermeable backsheet. The topsheet of Roe comprises at least one treated hydrophilic zone – upper surface and at least one non-treated hydrophobic zone – lower surface (col. 6, lines 1-14). Given the broadest reasonable interpretation, any part of the hydrophilic treated topsheet can constitute a portion of the surface of the topsheet, and can be construed as a hydrophilic zone. Furthermore, because the claim states “at least one treated hydrophilic zone”, this allows for various portions of the topsheet to be construed as hydrophilic zones.

The treated hydrophilic zone of Roe comprises a surfactant (col. 6, lines 1-14) and a skin-wellness substance (col. 6, lines 32-53).

Roe discloses the treated hydrophilic zone is defined by an area that corresponds to a predetermined insult point that includes the central region and a male and female insult point in that the entire upper surface of the topsheet comprises the predetermined insult point.

As to claims 4 and 36, the skin-wellness substance is a substance effective or perceived as being effective in providing skin protection, skin care, skin improvement, or any combination thereof (col. 6, lines 32-53).

As to claims 5, 8, 20, 37, 40, and 51 Roe discloses the skin-wellness substance is selected from the claimed group of materials (col. 14, lines 15-47).



As to claims 6, 7, 38, and 39, Roe incorporates by reference suitable skin-wellness substances include Aloe and Vitamin E (col. 14, lines 43-47 refers to Roe USPN 5609587, which lists Aloe and Vitamin E as components of a skin-wellness substance col. 23, lines 28-44).

As to claim 30, the garment of Roe further comprises first and second leg gathers Figure 2.

11. Claims 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul et al. USPN 6217890.

As to claim 51, Paul discloses a composition in an absorbent article for providing leak protection and improved skin wellness comprising (Abstract and col. 10, lines 56-59): an amount of surfactant sufficient for rendering substantially hydrophilic an inherently hydrophobic material comprising nonwoven fibers or films (col. 13, lines 22-54); and a skin wellness substance selected from the claimed materials (col. 13 line 55 through col. 14, line 20).

As to claim 52, see col. 36, lines 39-48.

As to claim 53, Paul discloses a composition in an absorbent article for providing leak protection and improved skin wellness comprising (Abstract and col. 10, lines 56-59): an amount of surfactant (col. 36, lines 39-48) sufficient for rendering substantially hydrophilic an inherently hydrophobic material comprising nonwoven fibers or films (col. 13, lines 22-54); and a skin wellness substance selected from the claimed materials (col. 13 line 55 through col. 14, line 20).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 13, 18, 23, 28, 45, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roe in view of Guidotti et al. USPN 5741241.

Claims 13, 18, 23, 28, 45, and 50 recite length and width dimensions for the treated hydrophilic zone. It is obvious Roe has transverse and longitudinal dimensions of the topsheet (Figure 2) however Roe does not specifically disclose the dimensions. Although it is old and well known in the art to provide an insult area of a topsheet with an oval configuration, the examiner is relying on Guidotti to show a portion of an absorbent article being designated as a wetting area (Guidotti Figure 1, element 16 and col. 4, lines 16-26). Guidotti further discloses a hydrophilic layer 16 that functions as a receiving area and allows liquid to quickly flow penetrate and covers only the wetting

area (col. 4, lines 4-7, and lines 23-31). Based on the teachings of Roe and Guidotti, it would have been within the level of one of ordinary skill in the art to provide a hydrophilic oval area that corresponds to a wetting region to receive discharged body liquids that first contact the diaper surface for the quick penetration and dispersal of those body liquids.

Regarding the dimensions of the wetting region, it would have been an obvious matter of design choice to provide the topsheet and insult zones of Roe/Guidotti with the claimed dimensions, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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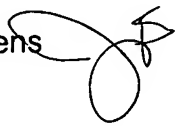
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703)308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Jacqueline F Stephens  
Examiner  
Art Unit 3761



  
**GLENN K. DAWSON**  
**PRIMARY EXAMINER**

January 11, 2004